

## **REMARKS**

Applicants reply to the Office Action mailed on July 12, 2005, within the shortened statutory period for reply. Claims 1-19 are pending in the application and the Examiner provisionally rejects claims 1-8 and 10-19 and rejects claims 1-19. Support for the amendments may be found in the originally-filed specification, claims, and figures. No new matter has been introduced by these amendments. Reconsideration of this application is respectfully requested.

The Examiner advised Applicants that under 37 C.F.R. § 1.56, Applicants are obligated to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made. Applicants respectfully assert that the subject matter of the various claims was commonly owned at the time the inventions covered therein were made and therefore, Applicants have complied with 37 C.F.R. § 1.56.

## **DOUBLE PATENTING**

The Examiner provisionally rejects the following claims under the judicially-created doctrine of double patenting: claims 1, 4, 8, 10, and 19 over claims 1, 4, 6, 7, and 9 of co-pending Application No. 10/708,823; claims 1-4, 8, and 10 over claims 1-4, and 7-8 of co-pending Application No. 10/708,824; claims 1-8 and 10-19 over claims 1, 2, 4-7, and 11-21 of co-pending Application No. 10/708,825, 10/708,826, 10/708,828, 10/708,830, 10/708,831, 10/708,832, and 10/708,834; claims 1-8 and 10-19 over claims 1-7, and 12-22 co-pending Application No. 10/708,827, 10/708,833, 10/708,835, 10/708,836; claims 1-8 and 10-19 over claims 1-7, and 13-23 of co-pending Application No. 10/708,829; and claims 1-7 over claims 1-7 of co-pending Application Nos. 10/708,837. While Applicants respectfully traverse these double patenting rejections, in the interest of compact prosecution, Applicants submit terminal disclaimers in compliance with 37 C.F.R. § 1.321(c). Applicants also assert that this non-statutory double patenting rejection is based on the above-listed applications which are all commonly owned with this application by assignee, American Express Travel Related Services Company, Inc.

### **35 U.S.C. § 103 REJECTIONS**

#### ***Rejections Under 35 U.S.C. § 103 (a) over U.S. Patent Application No. 2005/0005172 (“Haala”) in view of U.S. Patent No. 6,588,673 (“Chan”).***

The Examiner rejects claims 1-11 and 17-19 under 35 U.S.C. § 103 (a) as being unpatentable over Haala, U.S. Patent Application No. 2005/0005172, (“Haala”) in view of Chan et al., U.S. Patent No. 6,588,673, (“Chan”). Applicants respectfully traverse these rejections.

In general, Haala discloses a method and system for preventing a person from negotiating a transaction upon the occurrence of a preselected event, such as verification of the biometric sample. Haala teaches proffering a biometric and a data card to a reader in order to negotiate a transaction (paragraph [0038]), wherein the data card is coded to include biometric and profile information about a person (paragraph [0021]). However, Haala limits the profile information to non-financial or non-payment information such as “name, address, date and place of birth, citizenship, medical and/or personal history, criminal record, passport information (date of issuance, number, issuing country, validity period, etc.), immigration or non-immigration visa information (category and duration, issuing consulate/embassy, etc.), licenses (driver’s, pilot, etc.)” (paragraph [0035]). As such, Haala does not disclose the use of its transaction card for any type of payment function.

Moreover, Applicants assert that Haala teaches away from the use of a card that performs both biometric verification and payment because Haala discloses that a separate card is needed to conduct the financial transaction. As set forth in Haala, “[i]t is noted herewith that the security system of the present invention is not meant to substitute other conventional identification systems that are currently used to check or verify the validity or authenticity of persons or cards, such as credit cards...the crosscheck security system...functions as a prerequisite to conventional transaction systems where, for example, a credit card or other security card is used to obtain goods or services” (paragraph [0028]).

Further still, and as recognized by the Examiner, “Haala is silent to a transponder” (page 9). While the Examiner notes that “it is well known and conventional for smart cards/contactless IC cards to communicate wirelessly through an antenna” (page 9) and cites Chan for teaching cards that “transmit information contactlessly through radio waves” (page 10), Applicants respectfully disagree. The use of contactless technology with biometric security devices includes complex hardware, software, protocols, interfaces and the like. Chan discloses methods and

systems for inline pre-production data preparation and personalization solutions and only mentions contactless cards in passing (col. 1, lines 55). Chan fails to teach or disclose how to use a contactless card to perform a contactless transaction or to interface with a biometric security device. Further, there is no motivation to combine Haala and Chan for contactless payments because the inventions require different technology (for example, different cards, readers, security issues, etc.). Thus, neither Haala, Chan nor any combination thereof disclose or suggest a contactless card that performs both biometric verification and payment. As such, neither Haala, nor Chan, nor any combination thereof, disclose or suggest at least “a verification device configured to verify said proffered biometric sample to facilitate a payment transaction,” as recited by independent claim 1.

Claims 2-11 and 17-19 depend from claim 1 and contain all of the elements thereof. Therefore, Applicants assert that claims 2-11 and 17-19 are differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 2-11 and 17-19.

***Rejections Under 35 U.S.C. § 103 (a)—the Martizen and Chan References***

Claims 1, and 12-13 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Martizen et al., U.S. Patent Application No. 2002/0191816 (“Martizen”), in view of Chan. Applicants respectfully traverse these rejections.

Martizen generally discloses a system and method for entering information through biometric identifiers ([0005]). However, “Martizen is silent to a transponder” as noted by the Examiner (page 12). The Examiner cites Chan for contactless communication cards. However, as noted above, while Chan mentions contactless cards in passing (col. 1, lines 55), Chan fails to teach or disclose the how to use a contactless card to perform a contactless transaction. Further, there is no motivation to combine Martizen and Chan because contactless payments involve different technology than contact-based payment (for example, different cards, readers, security issues, etc.). Thus, neither Martizen nor Chan disclose or suggest a contactless card that performs both biometric verification and payment. As such, neither Martizen, Chan, nor any combination thereof, disclose or suggest at least “a verification device configured to verify said proffered biometric sample to facilitate a payment transaction,” as similarly recited by independent claim 1.

Claims 12 and 13 variously depend from claim 1 and contain all of the elements thereof. Therefore, Applicants respectfully submit that claims 12 and 13 are differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 12 and 13.

***Rejections Under 35 U.S.C. § 103 (a)—the Martizen and Moebs References***

Claim 14 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over Martizen in view of Moebs et al., U.S. Patent Application No. 2005/0065872 (“Moebs”). Applicants respectfully traverse this rejection.

Claim 14 indirectly depends from claim 1 and contains all of the elements thereof. Therefore, Applicants respectfully submit that claim 14 is differentiated from the cited references at least for the same reasons as set forth above, in addition to its own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 14.

***Rejections Under 35 U.S.C. § 103(a)—the Haala and Goodman References***

Claim 15 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over Haala, in view of Goodman et al., U.S. Patent Application No. 2002/0043566, (“Goodman”). Applicants respectfully traverse this rejection.

Claim 15 directly depends from claim 1 and contains all of the elements thereof. Therefore, Applicants respectfully submit that claim 15 is differentiated from the cited references at least for the same reasons as set forth above, in addition to its own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 15.

***Rejections Under 35 U.S.C. § 103(a)—the Haala and Teicher References***

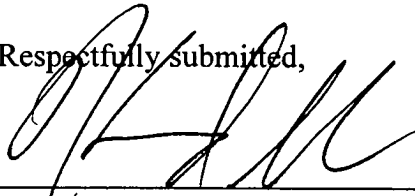
Claim 16 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over Haala in view of Teicher et al., U.S. Patent No. 6,257,486 (“Teicher”). Applicants respectfully traverse this rejection.

Claim 16 directly depends from claim 1 and contains all of the elements thereof. Therefore, Applicants respectfully submit that claim 16 is differentiated from the cited references at least for the same reasons as set forth above, in addition to its own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 16.

**CONCLUSION**

Applicants respectfully submit that the pending claims are in condition for allowance. The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 19-2814. Applicants invite the Examiner to telephone the undersigned if the Examiner has any questions regarding this Reply or the application in general.

Respectfully submitted,



Dated: August 10, 2005

By: \_\_\_\_\_

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